

REMARKS

The original application was filed on 30 March 2001 with twelve claims. In response to the first examination of the application mailed 24 March 2005 wherein claims 5, 6, 8, 9, and 12 were rejected under 35 U.S.C. §112, 2nd ¶, claims 1 and 4 were rejected under 35 U.S.C. §102(b), and claims 2, 3, 5-12 were rejected under 35 U.S.C. §103(a), Applicants amended claims, canceled claims 10-12 and added claims 13-20.

The Patent Office responded on 07 October 2005 and maintained the rejection of claims 6 and 9 under 35 U.S.C. §112, 2d paragraph, while new rejections of claims 1-9 and 13-20 under 35 U.S.C. §112, first and second paragraphs, and §101 were set forth. In response, Applicants amended claims 1, 6, 7, and 9.

The Patent Office responded with yet another Action mailed 03 April 2006, rejecting claims 1-9, 13-20 under 35 U.S.C. §112, 1st and 2nd ¶s, and maintaining the rejection under 35 U.S.C. §101. For the first time, the Examiner further rejected claims 1-9 and 13-20 under 35 U.S.C. §103(a) in view of Daskalantonakis, Michael K., "ACHIEVING HIGHER SEI LEVELS" IEEE COMPUTER, Vol. 27, No. 7, pp. 17-24, July 1994 (hereinafter referred to as Daskalantonakis) and Paulk, Market al., "Capability Maturity Model for Software, Version 1.3, Technical Report CMU/SEI-93-TR-024" SOFTWARE ENGINEERING INSTITUTE, Carnegie Mellon University, Pittsburgh, Pennsylvania, February 1993 (hereinafter referred to as CMM). Applicants amended the claims and canceled claim 20, to which the Patent Office responded with a final rejection of the claims mailed 25 September 2006.

Applicants filed a first Request for Continued Examination with a supplemental amendment canceling claims 13 and 19, adding claims 21 and 22, and rewriting claim 5 as claim 23. The claims were rejected yet again with claims 1-6 rejected under 35 U.S.C. §112, 1st ¶, under 35 U.S.C. §101, and claims 1-9, 14-18 and 31-23 under 35 U.S.C. §103(a) over CMM and Daskalantonakis. In response, Applicants amended claims 2, 6 and 23. The Patent Office responded on 07 August 2007 by withdrawing the rejections under 35 U.S.C. §§101 and 112, 1st paragraph, but finally rejecting the pending claims under 35 U.S.C. §103(a) over CMM and Daskalantonakis.

In this paper, Applicants respond and file a second Request for Continued Examination with a supplemental amendment of the specification and claims. In amending the specification and the claims, Applicants have not added new matter. Support for the amendments to the specification is given in US Patent 6950802 B1, which was incorporated by reference in the original application. Applicants maintain their traversal of the rejection of the claims as being obvious in view of CMM and Daskalantonakis. Claims 1-9, 14-18, 21-23 are pending.

The Rejection of claims 1-9, 14-18, and 21-23 under 35 U.S.C. § 103(a)

The pending claims are finally rejected as being obvious over CMM and Daskalantonakis. The rejection dismisses the claimed attributes as non-functional descriptive material that is not functionally involved in the steps recited and further alleges that the claimed attributes do not alter the recited structural elements. The rejection further alleges that the cited method steps would be performed the same regardless of the specific data, and that the descriptive material will not distinguish the claimed invention. Applicants traverse the rejection.

To evaluate the satisfaction and value of information technology services provided to a customer, Applicants claim a methodology using one or more engagement templates to elicit responses from an external customer regarding the purpose and objective of each information technology service; the extent of cooperation or teamwork between the information technology service provider and the customer; the consistency of delivery of the information technology service to the customer; the management and improvement of the delivery of the information technology service to the customer; and if the information technology service fulfills or satisfies the customer's expectations. The one or more claimed engagement templates further present questions, a focus area, a description, a set of considerations, and an example of each of the five claimed attributes: An engagement template may be implemented as a database, such as a relational or hierarchical database, or as a knowledge-based system, or the like, which may be accessed and manipulated by way of a browser or some other user terminal application via the Internet, intranet or some other network.

The rejection cites In re Gulack, 703 F.2d 1381 (Fed Cir. 1983) and In re Lowry, 32 F.3d 1579 (Fed. Cir. 1994). Reading these cases in view of the claimed subject matter of the present application, however, urges a different conclusion than rejection of the claims, and indeed favors allowance of the claims. The issued rejection modified the phrase "printed matter" which was at

issue in the cases cited with the phrase “non-functional descriptive matter.” Applicants traverse the rejection because the claimed attributes are not non-functional descriptive matter.

Under 35 U.S.C. §103 and Graham v. John Deere Co., 383 U.S. 1 (1983), the claim must be read as a whole. By ignoring or dismissing the claimed attributes, the claim is not considered as a whole, a fundamental tenet of claim examination. A rejection cannot be sustained if the claim is dissected, the non-functional descriptive material excised from it, and then the remaining portion of the mutilated claim is declared to be unpatentable. In re Gulack, 703 F.2d at 1385. If the rejection is based on disregard of the basic principles of claim interpretation, then it must fail [or be reversed] as a matter of law. Id. Gulack, 703 F.2d at 1386, moreover, requires that the differences between a claimed invention and the prior art cited against it cannot be ignored merely because those differences reside in the context of the printed matter [the non-functional descriptive material]. The rejection does not establish that the attributes within the context of the entire claim lack a new and nonobvious functional relationship to evaluating customer satisfaction and value of the information technology services. *See also* MPEP 2106.01 wherein descriptive material consists of data structures and computer programs, or of music literary works or compilation or mere arrangement of data.

The claim limitations of the focus areas and service attributes are not merely descriptive material, but are functionally involved in the method steps recited. Independent claims 1 and 7 specifically state that the claimed engagement template facilitates, *inter alia*, evaluating the attributes of understanding the service and the customer, executing the service, supporting the information technology services, and measuring and controlling the services. These attributes are not merely descriptive material but rather determine the scope of the inquiry, of the methodology, the claimed subject matter. Neither the CMM nor the Daskalantonakis reference, moreover, suggest or teach using these attributes to identify disparities of the information technology services provided as perceived by the both the provider of the service and the customer of the service. None of these attributes of the claimed methodology are mentioned by either reference. Functional limitations of the scope of the set of questions are not mere data; the attributes define are actual limitations on the acts being performed by the claimed method. Were it not for the functional relationships of the printed matter, the educational purposes of Gulack could not be realized; so it is here; were it not for the claimed attributes about which the methodology is designed to elicit information, the purpose of the methodology could not be

achieved. Just as in Lowry, the nature of the attributes does not represent mere underlying data or non-functional descriptive material. The inquiries into the attributes contain both information used by the methodology and information about how the information technology service providers evaluate the satisfaction and value of their service to the information technology customers. See In re Lowry, 32 F.2d at 1583. The claimed method uses the attributes to more effectively evaluate customer satisfaction of information technology services using steps that have not been used before. In sum, the attributes perform a function and Gulack requires no more. Lowry, 32 F.2d at 1584.

Respectfully, Applicants assert that neither reference teaches or suggest a method of evaluating the satisfaction nor value of IT services by evaluating the claimed attributes. Applicants request the Examiner withdraw the rejection under 35 U.S.C. §103(a).

Conclusion

Applicants have overcome the rejection of the claims under 35 U.S.C. &103(a) because the differences between CMM and the claims are, *inter alia*, novel and nonobvious engagements templates used to evaluate the satisfaction and value of IT services using at least the claimed attributes. The Examiner is requested to telephone the attorney below if it would expedite issuance and allowance of the case.

Please charge any additional fees or credit overpayment to Deposit Account No. 09-0457.



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Respectfully submitted,

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